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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/245,798	02/05/1999	MIKE O'DONNELL	1690-1-1	5408
996	7590	07/12/2004	EXAMINER	
GRAYBEAL, JACKSON, HALEY LLP 155 - 108TH AVENUE NE SUITE 350 BELLEVUE, WA 98004-5901			VAN DOREN, BETH	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/245,798

Applicant(s)

O'DONNELL ET AL.

Examiner

Beth Van Doren

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. The following is a non-final office action in response to communications received 04/28/04. Claims 84, 86, and 93 have been amended. Claims 94-118 have been added. Claims 84-118 are now pending in this office action.

Response to Amendment

2. Applicant's amendments to claim 84 and 93 are sufficient to overcome the 35 USC § 112, second paragraph, rejections set forth in the previous office action.

Response to Affidavit

3. Applicant submitted a 37 CFR 1.131 affidavit in the communications of 04/28/04. After consideration, the affidavit has been found persuasive and the prior art asserted in the previous office action has been withdrawn. New art rejections have been asserted below.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 88-91, 93, 95-97, 99-103, 105-110, 112-116, and 118 rejected under 35

U.S.C. 102(b) as being anticipated by the Digital Object Identifier (DOI) system. The following references disclose aspects of the DOI system:

- i. Article "STM houses, CCC showcase latest DOI prototype via AAP" by Calvin Reid (referred to herein as reference A);

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ii. Article "Metadata for the Millennium" by James Lichtenberg (referred to herein as reference B);

iii. Article "AAP unveils DOI as PSP Confab" by Calvin Reid (referred to herein as reference C);

iv. Article "Association of American Publishers proposes a digital object identifier (DOI) or electronic access to publications" from *Information Intelligence, Online Libraries, and Microcomputers* (referred to herein as reference D).

5. As per claim 84, the Digital Object Identifier (DOI) system teaches a method in a networked computer system for offering to recipients of published works of authorship a license to use a work of authorship, comprising:

a. having on a computer network a license offering server that presents licensing web pages, each licensing web page associated with one of a plurality of viewable works of authorship and with a unique work identifier, each licensing web page presenting to any of a plurality of client computers on the network an offer of a license to use the associated viewable work of authorship (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, wherein on a computer network a server present licensing web pages. The licensing web page is associated with a viewable work and a unique identifier assigned to the work. The licensing web page provides a consumer, etc., with the ability to see licensing information associated with the work);

b. from a server on the computer network, providing to a client computer on the network one of said works of authorship and causing the client computer to display, as a displayed part of

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said viewable work viewable in a single window, a hotspot which, when selected at the client computer, uses the unique work identifier associated with said work to direct the client computer to the licensing web page for the associated work of authorship (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, wherein the user encounters a digital work on the network and the user clicks of the DOI graphic, which links the user to a licensing page associated with the work); and

c. receiving at the license offering server a request from the client computer to present the licensing web page for the associated work of authorship (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, wherein the query is received via the DOI graphic).

6. As per claim 85, DOI system teaches a method wherein the hot spot includes an icon representing an action to obtain a license relating to the work of authorship (See at least reference C, page 1, sections 2-3, which discusses the DOI graphic which the consumer clicks on).

7. As per claim 86, the DOI system discloses a method wherein the work of authorship is a text article (See at least reference A, page 1, section 1, and reference D, section 1, which discusses an article).

8. As per claim 87, the DOI system teaches a method wherein the unique work identifier is a universal resource name within the network (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3).

9. As per claim 88, the DOI system teaches a method wherein the unique work identifier includes an identifier of the publisher of the work (See at least reference A, page 1, section 2,

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and reference B, page 2, sections 2-4, wherein the unique work identifier includes an identifier of the publisher).

10. As per claim 89, the DOI system discloses a method wherein each licensing web page includes one or more of: a title of the associated work, a name of an author of the associated work, and a name of a publisher of the associated work (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, reference C, page 1, sections 2-3, and reference D, sections 1-3, wherein the licensing web page identifies at least the publisher).

11. As per claim 90, the DOI system discloses a method wherein each licensing web page includes a field in which a type of permission can be selected (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, reference C, page 1, sections 2-3, and reference D, sections 1-3, wherein type of permission can be selected).

12. As per claim 91, the DOI system teaches a method wherein the associated licensing web page includes a field in which a portion of the article to be used can be specified (See at least reference A, section 1, reference C, section 2, and reference D, sections 1-3, wherein portions of the work can be specified).

13. As per claim 93, the DOI system teaches a method wherein the computer network comprises the global computer network (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, wherein the network is a global network).

14. As per claim 95, the DOI system teaches a data carrier carrying computer programs which, when run on at least one server computer on a network causes the at least one server

computer to offer to recipients of published works of authorship a license to use a work of authorship by implementing a method comprising:

a. presenting licensing web pages, each licensing web page associated with one of a plurality of viewable works of authorship and with a unique work identifier, each licensing web page presenting to any of a plurality of client computers on the network an offer of a license to use the associated viewable work of authorship (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, wherein on a computer network a server present licensing web pages. The licensing web page is associated with a viewable work and a unique identifier assigned to the work. The licensing web page provides a consumer, etc., with the ability to see licensing information associated with the work);

b. providing to a client computer on the network one of said works of authorship and causing the client computer to display, as a displayed part of said viewable work viewable in a single window, a hotspot which, when selected at the client computer, uses the unique work identifier associated with said work to direct the client computer to the licensing web page for the associated work of authorship (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, wherein the user encounters a digital work on the network and the user clicks of the DOI graphic, which links the user to a licensing page associated with the work), and

c. receiving a request from the client computer to present the licensing web page for the associated work of authorship (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, wherein the query is received via the DOI graphic).

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15. As per claims 96, 97, 99, 100-103, and 105, claims 96, 97, 99, 100-103, and 105 recite equivalent limitations to claims 85, 86, 91, 87-90, and 93, respectively, and are therefore rejected using the same art and rationale as applied in the rejection of claims 85, 86, 91, 87-90, and 93, respectively.

16. As per claim 106, the DOI system teaches a data carrier wherein the data carrier is a memory (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, which discloses memory, databases, saved directories, etc.).

17. As per claim 107, the DOI system discloses a data carrier wherein the data carrier is signal transmitted on a computer network (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, which discloses a signal on a network).

18. As per claim 108, the DOI system teaches a system of one or more servers on a computer network for offering to recipients of published works of authorship a license to use a work of authorship, comprising:

a. a license offering component that presents licensing web pages, each licensing web page associated with one of a plurality of viewable works of authorship and with a unique work identifier, each licensing web page presenting to any of a plurality of client computers on the network an offer of a license to use the associated viewable work of authorship (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, wherein on a computer network a server present licensing web pages. The licensing web page is associated with a viewable work and a unique identifier assigned to the

work. The licensing web page provides a consumer, etc., with the ability to see licensing information associated with the work);

b. a work delivery component that provides to a client computer on the network one of said works of authorship and causes the client computer to display, as a displayed part of said viewable work viewable in a single window, a hotspot which, when selected at the client computer, uses the unique work identifier associated with said work to direct the client computer to the licensing web page for the associated work of authorship (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, wherein the user encounters a digital work on the network and the user clicks of the DOI graphic, which links the user to a licensing page associated with the work); and

c. a request receiving component that receives a request from the client computer to present the licensing web page for the associated work of authorship (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, wherein the query is received via the DOI graphic).

19. As per claims 109-110, 112, 113-116, and 118, claims 109-110, 112, 113-116, and 118 recite equivalent limitations to claims 85-86, 91, 87-90, and 93, respectively, and are therefore rejected using the same art and rationale as applied in the rejection of claims 85-86, 91, 87-90, and 93, respectively.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 92, 94, 98, 104, 111, and 117 rejected under 35 U.S.C. 103(a) as being unpatentable over the Digital Object Identifier (DOI) system. The following references disclose aspects of the DOI system:

- i. Article "STM houses, CCC showcase latest DOI prototype via AAP" by Calvin Reid (referred to herein as reference A);
- ii. Article "Metadata for the Millennium" by James Lichtenberg (referred to herein as reference B);
- iii. Article "AAP unveils DOI as PSP Confab" by Calvin Reid (referred to herein as reference C);
- iv. Article "Association of American Publishers proposes a digital object identifier (DOI) or electronic access to publications" from *Information Intelligence, Online Libraries, and Microcomputers* (referred to herein as reference D).

21. As per claim 92, the Digital Object Identifier (DOI) system discloses hotspots, clicking on hotspots, and a method wherein each licensing web page includes the ability to accept the offered license terms (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, wherein a consumer clicking on a hotspot directs the consumer to a licensing page. Using the licensing page, the user can accept licensing terms and perform commercial transactions). However, the DOI system does not expressly disclose selecting a hotspot to indicate that the license terms have been accepted.

The DOI system discloses hotspots, clicking on hotspots to link to perform actions, and using a presented licensing web page associated with the work to accept the offered license

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terms. Clicking on a hotspot on a website to accept terms associated with the page was well known in electronic transactions at the time of the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a hot spot in licensing web page to enable the user to accept the terms in order to increase the ease of use of the system for the consumer by placing a link by which the user can automatically and efficiently accept the terms. See at least reference B, page 2, sections 1-4, and reference D, section 1, which discusses increasing the ease with which the consumer can identify the owner of a work of authorship and license said work.

22. As per claim 94, the DOI system discloses a method wherein the text article has a beginning and an end and the hotspot is inscribed in the text article (See at least reference A, page 1, section 2, reference C, page 1, sections 2-3, and reference D, section 1, which discloses a text article and an inscribed DOI graphic). However, the DOI system does not expressly disclose that the hotspot is inscribed at the end of the text article.

The DOI system discloses a text article viewable on a network with an inscribed DOI graphic that allows a consumer to link to licensing information associated with the work. It would have been obvious to one of ordinary skill in the art at the time of the invention to place this graphic hotspot at the end of the article of the DOI system in order to increase the ease of use of the system for the consumer by placing the link at the end of the article so that the consumer will come upon the link just after he/she finishes reading the article. See at least reference B, page 2, sections 1-4, and reference D, section 1, which discusses increasing the ease with which the consumer can identify the owner of a work of authorship.

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23. As per claims 98 and 104, claims 98 and 104 recite equivalent limitations to claims 94 and 92, respectively, and are therefore rejected using the same art and rationale as applied in the rejection of claims 94 and 92, respectively.

24. As per claims 111 and 117, claims 111 and 117 recite equivalent limitations to claims 94 and 92, respectively, and are therefore rejected using the same art and rationale as applied in the rejection of claims 94 and 92, respectively.

Response to Arguments

25. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stefik et al. (U.S. 5,629,980) discloses controlling the distribution and use of digital works over a network.

Berinstein ("DOI: A new identifier for Digital Content") teaches a DOI identifier tat links a user and a right-holder/distributor of a published and/or copy-righted work.

Jacobson ("Internet Tools designed to block unauthorized uses of copyright works") discloses electronic techniques that allow online publishers to block unauthorized use of works.

"Design Intelligence" (Business Wire) discloses a copyright permissions clearinghouse with a copyright button to access licensing use and policy information.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (703) 305-3882.

The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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July 2, 2004

Susanna Diaz
SUSANNA M. DIAZ
PRIMARY EXAMINER

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